GP 1807
#19
B. Leary
5-6-96
(WE)

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE EXAMINING
GROUP NO. 1807

ISIS-1169

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Cook and Manoharan

Serial No.: 08/117,363 Group Art Unit: 1807

Filed: September 3, 1993 Examiner: S. Houtteman

For: AMINE-DERIVATIZED NUCLEOSIDES AND OLIGONUCLEOSIDES

I, Joseph Lucci, Registration No. 33,307 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

On April 26, 1996

Joseph Lucci Reg. No. 33,307

Box AF
Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

This responds to the Advisory Action mailed April 8, 1996, in connection with the above-identified patent application.

The Advisory Action indicates that the claim amendments set forth in Applicants' Request For Reconsideration mailed March 11, 1996, have not been entered (and that the remarks set forth therein have not been considered) because the amendments allegedly raise "new issues under § 112, first paragraph." Applicants respectfully request that the amendments be entered (and that the remarks be considered), as the amendments do not raise any new issue, but merely address a new issue first raised by the Examiner in his second (and final) Office Action.

In the Office Action mailed December 11, 1995, the Examiner rejected claims 1-29 for alleged lack of enablement with respect to the size of substituents having formula $-R_A-N(R_{1a})(R_{1b})$ wherein R_A is $(CH_2-CH_2-Q)_x$ and subscript x is 1-200. This was the first time during prosecution of this patent application that any rejection had been entered regarding such substituents.[1]

In response to the December 11, 1995, Office Action, Applicants amended the claims to recite preferred compounds wherein x is 10-50. It is not seen how this amendment raised any "new issue." If anything, the amendment simply addressed an issue that had been newly raised by the Examiner. Indeed, the fact that the Examiner raised this issue for the first time in his second and final Office Action -- together with the fact that the definition of subscript x to that point had not been the subject of any amendment -- calls into question whether it was proper for the Examiner to make the December 11, 1995, Office Action final. M.P.E.P. § 706.07(a), for example, specifically advises that second or subsequent Office Actions should ***not*** be made final "where the examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant." Accordingly, Applicants respectfully request that

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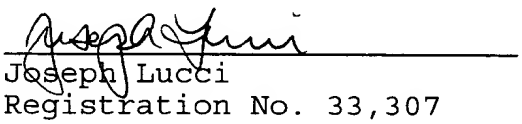
[1] The Office Action mailed December 30, 1994, rejected the claims for alleged lack of enablement with respect to the length of internucleoside linkages in the claimed compounds. (Office Action at pages 3-4). The present issue, however, is quite different. Indeed, the claims do not require that substituent $-R_A-N(R_{1a})(R_{1b})$ be attached to any internucleoside linkage, but, rather, that it be attached at a nucleoside 2'-O-, 3'-O-, or 5'-O-position.

the Request For Reconsideration mailed March 11, 1996, be entered and that the issues raised therein be given full consideration on the merits.

The Advisory Action indicates that the Examiner was not able to find support in the specification for defining subscript x as about 10 to about 50 (although the specification clearly states that x can be about 10 to about 50) because "the new claims suggest that 1-10 is as preferred as 10-50." Applicants note, however, that none of the claims define x as 1-10. Thus, "the new claims" cannot possibly negate the clear support provided by the specification for the recited definition of subscript x.

It is believed all of the claims presently before the Examiner patentably define the invention over the prior art and are otherwise in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,



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Date: April 26, 1996

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